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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,035	12/01/2003	Thomas D. Jackson	TDJ-226r	4726

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EXAMINER

SPISICH, MARK

ART UNIT PAPER NUMBER

1744

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/726,035

Applicant(s)

JACKSON, THOMAS D.

Examiner

Mark Spisich

Art Unit

1744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13 is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4,7 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Cazal (USP 1,760,815). The patent to Cazal discloses a shoe cleaning device comprising a unitary frame comprising a body portion (3) to which a cleaning unit (7) is mounted and an appendage portion (4) including apertures (5) for threaded fasteners for attaching the device to a supporting surface. The recitation of the bumper fails to materially limit the structure of the cleaning device.
3. Claims 1,3,4,7,8 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Callender (USP 1,534,156). The patent to Callender discloses a shoe cleaning device comprising (in the embodiment of fig 2) a unitary frame comprising a body portion (A) for mounting a cleaning unit (E) and an appendage portion (lower right in fig 2) with each of the body and appendage portions including apertures. The recitation of "for engaging a bumper on a vehicle" does not materially limit the structure of the claim(s).
4. Claims 1-4,7,11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Linville et al (USP 1,389,201). The patent to Linville discloses a shoe cleaning

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device comprising a unitary frame comprising a body portion (14,15,16) and an appendage portion including an aperture for an screw (20) for attachment to a support surface and further including a cleaning unit (17) secured to the body portion. Again, the recitation of "bumper" fails to materially limit the structure of the claim(s).

5. Claims 1,2,5,7,11 and 12 are rejected under 35 U.S.C. 102(a) as being anticipated by MacDonald (USP 6,530,105). The patent to MacDonald discloses a shoe cleaning comprising a frame comprising a body portion as well as an appendage portion (52,54) and further including a cleaning unit (22) mounted to the body portion. The term "unitary" in claim 1 is a broad term and is essentially equivalent to the term "integral". Such term has been held to be sufficiently broad to embrace constructions united by such means as fastening and welding. In re Hotte, 177 USPQ 326,328 (CCPA 1973).

6. Claims 1,2,5-7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Peake (USP 5,437,075). Applicant's use of the term "unitary" alone is broader than intended. With regard to claim 9, the appendage (12) need only have apertures (14). It is noted that claim 9 does not positively recite the strap ties.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linville (USP 1,389,201). The patent to Linville discloses the invention substantially as claimed with the exception of the strap. One of ordinary skill would deem it obvious to utilize any number of known mechanical fastenings instead of or in addition to the screws (20), including the recited strap(s) of claims 9-10.

Allowable Subject Matter

9. Claim 13 is allowed.

Response to Arguments

10. Applicant's arguments filed 21 October 2004 have been fully considered but they are not persuasive. Applicant's arguments will be addressed in the order they appear in the "remarks". The first would pertain to the interpretation of the term "unitary". Once a device is assembled, it is a "single piece" (i.e. unitary). The further statement that the frame member is formed by folding a single piece of material by bending to form the body and appendage portions is noted; however, the claim is silent with regard to this and only uses the term "unitary". Applicant's arguments are NOT a substitute for a positive recitation in the CLAIMS. The term "body portion" in no way would require that it be triangular. Claim 1 is totally silent with regard to ANY shape of the body portion, let alone triangular. The shape of the body portion is not mentioned until claim 5.

Differences in the disclosure of the present invention and that of the prior art are noted; however, it is the CLAIMS and not the specification which must define over the prior art. Linville (USP 1,389,201), Cazal (USP 1,760,815) and Callender (USP 1,534,156) each discloses a body portion and an appendage portion which are unitary (even as argued

by applicant) and further wherein the appendage portion are adapted to mount the device to a support. The devices of Cazal, Linville and Callender are each perfectly capable of "engaging a bumper". The screws (that pass through the holes 5) in Cazal and the means (20) in Linville would enable them to be attached to a bumper. A recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. For example, the "appendage" of figure 3 of the present application is merely two tabs which by themselves are capable of engaging a bumper to the same extent as that of the prior art. It is pointed out that any such "attachment means" is not recited until claim 2.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Spisich whose telephone number is (571) 272-1278. The examiner can normally be reached on M-Th (5:30-3:00), Alternate Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J Warden can be reached on (571) 272-1281. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MS



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